

**REMARKS**

Claims 1-13 are pending in this application; claim 14 is cancelled. Claims 1-13 have been amended to place them in U.S. form. Applicant submits that no new matter has been added.

Claims 1-4 and 7-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Henderson (U.S. Patent No. 6,491,699) in view of Taylor (U.S. Patent No. 5,695,500). Applicant traverses the rejection.

Applicant submits that neither Henderson nor Taylor depict or suggest the claimed invention. One embodiment of a bone marker described by claim 1 is depicted in Figure 1. The bone marker includes a support (referred to generally as reference numeral 3) having an anchor mechanism for anchoring the support in a bone (referred to by reference numeral 2), and at least one reference member detectable by an image guided system that is attached to the support (reference numeral 25). The at least one reference member is attached to the support, and the support includes at least one limb (20) that is resiliently deformable.

Turning to the cited prior art, with regard to Henderson, the reference numeral 10 refers to an image guided surgery system, not a bone marker. Henderson appears to describe two examples of bone markers, however, that have reference markers and a structure that attaches to bone. The first example is base plate 140, which attaches to bone at one point and is attached to tracking markers 144 at another point. The second is position frame 17, which attaches to bone on one side and has reference markers 174 screwed in on the other side. The structure that would be analogous to the claimed “support” element of the claimed invention in Henderson would be reference frame 152 in the first example, and reference frame 170 in the second example. As the Examiner has indicated, Henderson does not describe a support that includes a limb that is resiliently deformable.

Taylor also depicts bone markers in Figures 5 and 6. These bone markers include a pin 225 and a beacon 224. But, again, the bone markers of Taylor do not have a support that includes a limb that is resiliently deformable.

As the Examiner points out, Taylor does describe a link or rail that is attached to springs. The link of Taylor, however, is not taught to be “deformable”. Link 20 may be moved vertically as shown by arrow C in Figure 1A of Taylor (see generally col 7:42-60), but the link 20 is solid; it is not deformable. Nor is the link of Taylor “resiliently deformable”. That claimed term is defined in the specification of the current application at paragraph 16 of U.S. Patent Publication No. 2007/0055232: “a resiliently deformable limb is sufficiently resilient so that the limb returns back to approximately its original position after it has been deformed.” As the Examiner indicates, the link 20 of Taylor is designed to be easily movable, not deformable or resiliently deformable.

Finally, even if Taylor described a resiliently deformable limb, one skilled in the art would not be motivated to combine Taylor with Henderson for the reason proposed by the Examiner. The current invention is not designed to make the limb more easily movable by the surgeon, as the counterbalance system makes link 20 more easily moved by the surgeon. Instead, in the event that the limb is inadvertently contacted by the surgeon, the resiliently deformable limb is designed to return to approximately its original position after it has been deformed. The claimed limb is not designed to be moved; instead, it is designed so as to maintain its position.

Because neither Henderson nor Taylor teach the claimed elements of claim 1 either independently or collectively, Applicant submits that claim 1 is patentable over the combination and requests that the rejection be withdrawn.

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Henderson in view of Taylor and further in view of Tontarra; claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Henderson in view of Taylor and further in view of Burbank. Applicant traverses these rejections. Applicant maintains that claims 5 and 6 are allowable at least because they depend from claim 1, which is patentable subject matter. For at least that reason, Applicant submits that claims 5 and 6 are also patentable and seek withdrawal of the rejections.

Applicant grants the Commissioner permission to charge the deposit account no. 10-0750/DEP5167/BST for any fees or charges related to this application. Applicant respectfully requests the Examiner to contact the below-signed if a discussion regarding the merits would advance prosecution of this case.

Respectfully submitted,

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